# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/749,558 | 01/02/2004 | Hsiang-Tsung Kung | 6720.0110-01 | 8770 |

22852          7590          11/28/2007
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|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2134 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 11/28/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Advisory Action Before the Filing of an Appeal Brief** | 10/749,558 | KUNG, HSIANG-TSUNG |
| | **Examiner** | **Art Unit** | |
| | Ellen C. Tran | 2134 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED <u>05 November 2007</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

     Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

     NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: <u>1, 3-38, 40-81</u>.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

*Ellen Tran, Patent Examiner, Art 2134*

U.S. Patent and Trademark Office

PTOL-303 (Rev. 08-06)       Advisory Action Before the Filing of an Appeal Brief       Part of Paper No. 20071126

Continuation of 11. does NOT place the application in condition for allowance because: no arguments or amendment was presented that overcomes the Final Office Action rejection mailed 6 August 2007.

In response to Applicant's argument beginning on page 3, "Applicant respectfully traverses the rejection of claims 1-5, 10-13, 15-17, 20, 21, 27, 38-42, 46-50, 52-54, 57, 58, 62, and 74-81 under 35 U.S.C. 103(a) as unpatentable over Murphy et al. in view of Ishibashi et al., because a prima facie case of obviousness has not been established ... Neither Murphy et al. nor Ishibashi et al. teaches or suggest a PAD comprising "at least one storage medium storing at least one CA public key,...[and] a processing component for authenticating [] one or more received digital certificates using the at least one stored CA public key." ... The Examiner considered the smart card as corresponding to Applicant's claimed PAD. Final Office Action, page 3. However, Murphy et al. fails to teach that the smart card comprises "at least one storage medium storing at least one CA public key." The Examiner disagrees with argument and notes that smart cards are known to contain storage and that the following is from Murphy and referenced in the Office Action: in '744 col. 5, lines 52-65 "FIG. 3 is a block flow diagram of steps performed in accordance with one embodiment of the invention. As shown in FIG. 3, a Certified Authority (CA) distributes smart card 10 to a user at step 50. Smart card 10 stores user information provided by the CA, such as tokens, digital signatures, certificates, tickets, PIN, human resources identification number, and so forth, or personal information provided by the user such as a social security number, birth date, mother's maiden name, etc. Smart card 10 also performs data encryption and decryption functions, stores DES secret keys and digital certificates, and will generate and store public and private RSA cryptographic key pairs. Smart card 10 has an on-board math co-processor that performs the key generation and encryption/decryption calculations", Note the CA distributes the smart card that stores public and private RSA cryptographic key pairs, therefore the smart card is interpreted to be a PDA that stores CA public key.

In response to Applicant's argument on page 5, "Moreover, the smart card taught by Murphy et al. does not authenticate one or more digital certification. Rather, "[a] [s]ecure gateway server 18 initiates authentication of the user of smart card 10 using authentication module 32." ... Murphy et al. fails to teach or suggest at least that the smart card comprises "a processing component for authenticating [] one or more received digital certificates using the at least one stored CA public key," as recited in claim 1. The Examiner disagrees with argument and notes that references are relevant for all information they contain. As shown above the smart card has an on-board co-processor, in addition as disclosed in col. 7, lines 22-28 "It is worth to note that the specific data being stored and retrieved from the smart card in this example of a smart card interface module is in the form a user's social security number (SSN) for use in authenticating the user. It can be appreciated, however that any type of data could be stored or retrieved from the smart card, such as tickets, certificates, public/private keys, and so forth". Therefore the smart card with the use of the interface module can retrieve information on the smart card such as public/private keys and the certificate can be retrieved from the smart card for authentication.

In response to Applicant's arguments beginning on page 5, "Ishibashi et al. does not cure the deficiencies of Murphy et al. ... further in view of de Jong et al. ... in view of Chang et al. and Yu et al., ... further in view of Teicher et al. ... and Geer, Jr et al. ... and Baird, III et al. ... Teppler". As stated above Murphy teaches a personal data unit that stores a CA public key that is used to authenticate a certificate, therefore the rejection is proper.

2